

REMARKS

This is in response to the Office Action mailed on April 1, 2003 in which claims 1-22 were pending. In the Office Action, claims 1-22 were rejected under 35 U.S.C. §103(a) as being unpatentable over Fournies et al., U.S. Pat. No. 6,236,851 ("the Fournies patent"), in view of Wagner et al., U.S. Pat. No. 6,366,967 ("the Wagner patent"). As will become clear from the discussion below, all of pending claims 1-22 are allowable over the cited reference.

It is important to understand that the purpose of the present invention is to propose a method or process for making remote payments for the purchase of foods and/or services through a mobile phone. Specifically, one of the purposes of the present invention is precisely to provide a process for secure remote payment for goods and/or a service purchased from a supplier making use of a mobile phone. For the purposes of this invention, it is assumed that remote payment for goods or services through a mobile phone is made through a closed type radiocommunications network.

A closed radiocommunications network may obviously be connected to one (or more) open networks through platforms or gateways. Thus, a user of the closed radiocommunications network can use his mobile phone to access an open network. For example, the Internet open network can be accessed using a mobile phone from a GSM network if the mobile phone has the means (such as a navigator or browser) of using a protocol based on a specific language (such as HDML, WML, or any other language of the same type and/or derived from).

The Fournies patent discloses a way to allow only pre-authorized users to complete cellular telephone calls and only within the closed network. *See Col. 7, lines 14-22*. More specifically, the Fournies patent allows users to purchase air time in the form of pre-paid cards for use with the closed network in order to make and receive telephone calls. *See Col. 11, line 57 through Col. 12, line 21*. Operating totally within a closed network, the functionality described in the Fournies patent has little to do with the present invention.

In fact, the Fournies patent is a good example of the prior art cited in the specification of the present invention. Since closed radiocommunications networks do not enter into the category of open data processing (computer) telecommunications networks, the content and solution recommended by the Fournies patent (U.S. Pat. No. 6,236,851) cannot be applied to the problem

solved by the present invention, specifically remote payment for goods and services on an open network using a closed network radiotelephone. In the Fournies patent, there is no way at all to communicate outside the closed radiocommunications network with a payment server or a sales server located within an open network.

While the Fournies patent provides a secure way to allow establishment of a telephone call, the first step of the process of the present invention begins only after getting the allowance for the call. In other words, the first step of the present invention begins after the call has been established. Specifically, previously amended claim 1 requires "identification of the buyer by the management center and/or the payment server and/or a control center based on a request from the supplier within the open network", a step that takes place after the buyer connects to the closed network and makes a purchase from the supplier. In the Fournies patent, there is no disclosure relating to communication with payment or sales servers located outside the closed telecommunications network, such as a payment server located within an open network.

In the Office Action, the alleged teachings of the Fournies patent are combined with the alleged teachings of the Wagner patent to reject claims 1-22 of the present invention under 35 U.S.C. §103(a) as being unpatentable. However, neither the Fournies patent nor the Wagner patent contain any suggestion or motivation for making the suggested combination.

The Wagner patent relates to data transaction systems using non-standard input/output devices. This has little to do with the present invention or for that matter with the invention disclosed by the Fournies patent. In an obvious way, the Wagner patent and the present application relate to fully dissimilar subject matter. The only common points between the Wagner patent and the present invention relate only to the words "pin", "payment" and "HTML".

The Wagner patent is directed towards the description of an extension (enrichment) of the HTML language. The Wagner patent proposes to add "tags" to the standards for controlling terminal operations remotely. Terminals are Internet connected either directly or connected to a PC or another terminal itself Internet connected. Absolutely, nowhere can we find any mention or notion of a closed network, or even re-use of functionalities/native services of closed networks, that is to say identification/authentication.

The Wagner patent, via the use of a "tag", allows for triggering a banking PIN capture on a terminal dedicated to a transaction with a banking server. Once again, such a tag notion has absolutely nothing to do with the present application.

Additionally, the architecture disclosed in the Wagner patent is also fundamentally different from that of the present invention (See FIG. 1 and Col. 9, line 66- col. 10, line 19). In the present invention, HTML tags and the HTML language in general is undesirable, in part, because terminals are standards. The present invention operates at the server level (management, payment, control, etc.) where the reality and effectiveness of the transaction are checked with different means for the vendor.

In the Wagner patent (and not at all in the present application), a "payment" tag is used to trigger a payment on a banking protocol. Instead, the present invention authenticates a payment via a payment PIN code, cryptography or even an electronic signature (checked and authenticated by the management center for the vendor). *See* for example, Application, p. 12, lines 3-29.

Except for the use of the words "PIN" and "Payment", Wagner is drastically different from the present invention. The present invention, from a closed network (of the GSM type) allows the user to purchase goods or services in an open network using a "mediation server." The Wagner patent uses a web server (see Col. 10, line 1) and a Common Gateway Interface (CGI) for non-standard terminals to initiate, generate, or parse responses to commands on a terminal directly Internet connected or Internet connected via a PC using an HTML language which is here specifically extended. The Wagner patent discloses

"The preferred format for the INPUT tag which is used to identify input operations is also shown in FIG. 2. The TYPE and NAME attributes are used to define a non-standard I/O device or local storage variable for the input of data. The TYPE field values "text," "password," "checkbox," "radio," "submit," and "reset" are previously known, as are the attributes NAME, VALUE, CHECKED, SIZE, and MAXLENGTH. To support the extended capability of the present invention, the TYPE attribute preferably includes attributes MSRT1 for reading track 1 of a magnetic swipe reader, MSRT2 for reading a magnetic swipe reader track 2, KEY for reading input from a terminal command keypad, PIN for reading a personal identification number

pad, BCW for reading a bar code wand, MICR for reading a check magnetic code reader, ATM for reading a dollar amount via a key input mask, INT for reading an integer via a key input mask, LOCAL for reading input from a variable in the local storage of an I/O device, and AUTOSUBMIT for returning a FORM with information to the server.”

See Col. 12, lines 18-36 (emphasis added).

One other important different between the present invention and the Wagner patent relates to the identification of the user. The Wagner patent discloses identification via transmission by the client (See, for example, “MSRT1”, “MSRT2”, “KEY” and “PIN” in the underlined text in the passage above), while in the present application, the identification of the client is transparent (See Application p.10, lines 31-34). In other words, in the present invention, the management center transmits the identification received from the “GSM” network together with a possible identification phrase operated by the management center of the buyer using the mobile phone. By contrast, in the Wagner patent, the client inputs and generates the payment request upon reception of a payment command, which is quite unsecured and even unsafe.

As can be seen from the discussion above, the Wagner patent is quite unconnected with our invention. The Wagner patent is also unrelated to the Fournies patent. The suggested combination of the alleged teachings of the Fournies patent with the alleged teachings of the Wagner patent is not at all obvious or natural. Moreover, the suggested combination is unjustified and unfounded. Neither reference suggests any motivation for the combination. The disclosure of the present application is the motivation, and the combination of the cited references is made based on a hindsight reconstruction in light of the present disclosure.

“To establish a prima facie case of obviousness, the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant’s disclosure.”

See M.P.E.P. §2142. The Office Action points to no language in either the Fournies patent or the Wagner patent teaching or suggesting a basis for making such a combination. Moreover, no such suggestion or teaching is present in either case. Therefore, the suggested combination would not have been obvious to a worker skilled in the art at the time the invention was made.

The present invention is directed to a method or process for making secure remote payments for the purchase of goods and/or services (from an open network) via a mobile phone (connected through a closed type radiocommunications network). The elements of the present invention are not taught, suggested, or disclosed by either the Fougnyes patent or the Wagner patent. Moreover, there is no suggestion or motivation to combine the two references within their disclosures. The only motivation to make such a combination comes from the disclosure of the present invention, and the combination is nothing more than a hindsight reconstruction based on the Applicant's disclosure. Therefore, the rejection of claims 1-22 under 35 U.S.C. §103(a) is inappropriate and should be withdrawn.

All of pending claims 1-22 are in condition for allowance. Reconsideration and notice to that effect is respectfully requested. The Examiner is invited to contact the undersigned attorney at the telephone number listed below if such a call would in any way facilitate allowance of this application.

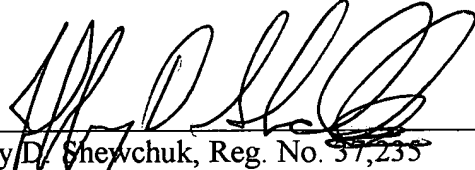
Respectfully submitted,

KINNEY & LANGE, P.A.

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July 3, 2003

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